

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-7 and 9-16 are pending in the application, with 1 and 10 being the independent claims. Claims 1, 3, and 10 are sought to be amended. Claim 3 is amended to clarify antecedent basis. Claim 8 is sought to be cancelled without disclaimer or prejudice to the subject matter therein. New claims 11-16 are sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Claim Objections

Paragraph 2 of the Office Action states "[a]pplicant is advised that should claim 4 be found allowable, claim 8 will be objected to under 37 C.F.R. § 1.75 as being a substantial duplicate thereof." Accordingly, Applicants have cancelled claim 8. Thus, Applicants respectfully request that this objection be withdrawn.

Rejections under 35 U.S.C. § 103

Claims 1-8 and 10

In paragraph 3 of the Office Action, claims 1-8 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,467,403 to Fishbine *et al.* (hereinafter Fishbine) in view of U.S. Patent No. 6,011,486 to Casey (hereinafter Casey). Applicants respectfully traverse the rejection.

As stated in M.P.E.P. § 2142, to establish a *prima facie* case of obviousness, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." Applicants respectfully assert that no such suggestion or motivation to combine Fishbine and Casey is present. Therefore, Applicants assert that a *prima facie* case of obviousness has not been established.

Fishbine appears to describe a fingerprint scanning apparatus. However, Fishbine does not teach or suggest a data and power communication interface that couples data between a fingerprint scanner and a docking station, and provides power to charge a rechargeable power supply of the fingerprint scanner, wherein said data includes information representative of a fingerprint image, where a dedicated plug for recharging the power supply separate from the interface can be avoided, as recited in claim 1 (as amended). This is supported on page 3 of the Office Action, which states, "Fishbine does not expressly teach the data and power communication interface, whereby a dedicated plug for recharging a power supply separate from a data interface can be avoided."

Casey appears to describe an electronic paging device. The paging device of Casey is used to receive and display messages, and to transfer the messages to the paging device user's computer. Casey describes a paging device 12 that includes a USB interface logic 33 coupled to a port 32 of the paging device 12 that is adapted for connection to a USB cable 17 (see FIG. 1; col. 3, lines 13-15).

On Page 3 of the Office Action, the Examiner attempts to combine Fishbine and Casey to provide all of the limitations of claim 1 of the present invention. Page 3 of the Office Action states:

At the time of the invention, it would have been obvious to one of ordinary [skill] in the art to apply Casey's plug to Fishbine's fingerprint scanner. A motivation for doing so would have been to take advantage of a USB connection, which for instance offers a high speed serial link useful for *image data transfer*.

(emphasis added). Contrary to this statement, however, Casey can not be combined with Fishbine. Casey does not teach or suggest "image data transfer." Casey relates to a pager device that displays messages and transfers the messages to a computer. Pagers are commonly known as devices capable of displaying textual messages. Thus, at most, Casey transfers textual message data. However, Casey *does not teach or suggest the transfer of image data*, and in particular, *does not teach or suggest the transfer of fingerprint image data*. Therefore, there exists no motivation to refer to Casey to find

any kind of communications link "useful for image data transfer," and in particular for the coupling of information representative of a fingerprint image, as is recited in claim 1 of the present invention.

Thus, contrary to the Examiner's assertion, there is no motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the teachings of Fishbine and Casey. Therefore, a *prima facie* case of obviousness has not been established.

For at least these reasons, claim 1 is patentable over Casey and Fishbine. Furthermore, for at least these reasons, and further in view of its own respective features, independent claim 10 (as amended) is likewise patentable over Fishbine and Casey. Claims 2-7, which depend from independent claim 1, and new claims 11-16, which depend from independent claim 10, are likewise patentable over the cited references for at least the reasons provided above, and further in view of their own features. Claim 8 has been cancelled. Accordingly, Applicants respectfully request that the rejection of claims 1-8 and 10 be reconsidered and withdrawn.

Claim 9

In paragraph 4 of the Office Action, claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Fishbine/Casey in view of U.S. Patent No. 6,154,010 to Geiger (hereinafter Geiger). Applicants respectfully traverse the rejection. As described above, claims 1-7 and 10-16 are patentable over Fishbine and Casey, taken alone or in combination. Applicants further assert that Geiger does not supply the missing teachings. Thus, Applicants assert that claim 9, which depends from claim 2, is

patentable over Fishbine, Casey, and Geiger, alone or combination. Accordingly, Applicants respectfully request that the rejection of claim 9 be reconsidered and withdrawn.

Other Matters

Applicants acknowledge with appreciation the Examiner's consideration of the documents listed on Forms 1449 filed with Information Disclosure Statements (IDSs) at the USPTO on June 29, 2001, and January 6, 2003. Applicants note that an IDS was also filed at the USPTO on October 10, 2000, in the present application, having a Form 1449 listing four documents. Accordingly, Applicants respectfully request that the Examiner provide an indication of his consideration of the documents of the October 10, 2000, IDS by appropriately initialing the Form 1449, and returning a copy of the initialed Form 1449 to Applicants.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will

expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Jeffrey A. W.", followed by a horizontal line.

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